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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,179	09/19/2003	Albert Lewis	7044	1608

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BONIARD I. BROWN
#113
1500 West Covina Parkway
West Covina, CA 91790

EXAMINER

BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,179

Applicant(s)

LEWIS, ALBERT

Examiner

Elizabeth A. Bolden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 3, 4, 6, 7, 9, -17, and 22-35 is/are allowed.
6) ☒ Claim(s) 1, 2, 5, 8, 18-21 and 36-39 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Specification

The disclosure is objected to because of the following informalities: Mechanical errors.

The composition exemplified on page 9 is listed as "Example 1 (Claim 3)"; reference to the claim numbers is not permitted in the specification, therefore the wording "(Claim 3)" should be deleted.

The composition exemplified on page 10 is listed as "Example 4 (Claim 8)"; reference to the claim numbers is not permitted in the specification, therefore the wording "(Claim 8)" should be deleted.

The composition exemplified on page 11 is listed as "Example 5 (Claim 9)"; reference to the claim numbers is not permitted in the specification, therefore the wording "(Claim 9)" should be deleted.

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The composition exemplified on page 11 is listed as “Example 6 (Claim 10)”; reference to the claim numbers is not permitted in the specification, therefore the wording “(Claim 10)” should be deleted.

The composition exemplified on page 12 is listed as “Example 7 (Claim 12)”; reference to the claim numbers is not permitted in the specification, therefore the wording “(Claim 12)” should be deleted.

In the newly added paragraphs starting on page 12, the first sentence states, “Set forth is a table which provides literal support for the respective compositions of oxides for each of Claims 1-20.” Since it is improper to refer to the claim numbers in the specification the Examiner recommends changing this sentence to read: “Set forth below is a table of compositions of oxides of the instant invention.”

Furthermore, Starting on page 12 the heading of the table should be changed from “Claims Table I” to “Table I” since claims should not be referred to in the specification. Additionally, the exemplified compositional ranges or compositions in the table should have “Example” numbers and not be listed as “Claim” numbers. The Examiner recommends renumbering the exemplified compositions in accordance with the examples, which already have Example numbers. For the exemplified ranges, the Examiner recommends labeling them “Range 1” and “Range 2”.

The composition exemplified on page 16 is listed as “Example 8 (Claim 24)”; reference to the claim numbers is not permitted in the specification, therefore the wording “(Claim 24)” should be deleted.

The composition exemplified on page 16 is listed as “Example 9 (Claim 30)”; reference to the claim numbers is not permitted in the specification, therefore the wording “(Claim 30)” should be deleted.

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The composition exemplified on page 17 is listed as “Example 10 (Claim 26)”; reference to the claim numbers is not permitted in the specification, therefore the wording “(Claim 26)” should be deleted.

The composition exemplified on page 17 is listed as “Example 11 (Claim 31)”; reference to the claim numbers is not permitted in the specification, therefore the wording “(Claim 31)” should be deleted.

In the newly added paragraphs starting on page 18, the first sentence states, “Set forth below is a table which provides literal support for the respective compositions of oxides for each of Claims 21-35.” Since it is improper to refer to the claim numbers in the specification the Examiner recommends changing this sentence to read: “Set forth below is a table of compositions of oxides of the instant invention.”

Furthermore, Starting on page 18 the heading of the table should be changed from “Claims Table II” to “Table II” since claims should not be referred to in the specification. Additionally, the exemplified compositional ranges or compositions in the table should have “Example” numbers and not be listed as “Claim” numbers. The Examiner recommends renumbering the exemplified compositions in accordance with the examples, which already have Example numbers. For the exemplified ranges, the Examiner recommends labeling them “Range 3” and “Range 4”.

Examiner's Comment

The Examiner would like to point out that the recitation in Claims 1, 3, 5, 6, 8-10, 12-17, and 21-35 which reads, “a batch blend to produce a glass composition useful for forming glass fibers of high heat resistance,” this preamble is mainly an intended use limitation. The phrases “to produce a glass composition” and “useful for forming glass fibers of high heat resistance” are intended use limitations and do not further limit the claim. However, the Examiner does give the limitation of “a batch blend” to refer to a batch of compositional component when blended and melted which would form a glass.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-20 and 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 18 –20 recite the limitation “The blend according to Claim 13 (14 or 17), wherein the batch is resistant to heat and fire for a substantial period of at least three hours to prevent burn-through by the conversion of at least a portion of the fibers into a fiber mat of ceram glass”. Although this recitation is supported by the specification for a **Glass Fiber**, the specification fails to support such a recitation for a **Batch Blend** in view of the above Examiner’s comment. With this taken into consideration, “the blend”, is a blend of the recited compositional components possibly but not necessarily in powder form, would not have to have the heat resistance of a fiber since the blend has not been melted into a glass. The batch blend is just capable of forming a glass, which could be used to make a glass fiber but does not limit the batch blend to be a fiber.

Claims 36-39 recite the limitation “The blend according to Claim 1 (or 21), wherein said fibers have diameters of 0.5 to 5 microns (or 0.7 to 3.0 microns)”. Although this recitation is supported by the specification for a **Glass Fiber**, the specification fails to support such a recitation for a **Batch Blend** in view of the above Examiner’s comment. With this taken into consideration, “the blend”, is a blend of the recited compositional components possibly but not necessarily in powder form, would not have to have the fiber diameter or even be in the form of a fiber.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 21, and 36-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Fyles et al., U.S. Patent 5,962,354.

Fyles et al. discloses a glass fiber having overlapping ranges of components with instant claims 1, 2, 5, and 21. See Abstract of Fyles et al. and column 5, lines 44-46. The compositional ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations in claims 1, 2, 5, and 21. See MPEP 2131.03. Fyles et al. discloses a glass fiber having overlapping ranges of fiber diameter with instant claims 36-39. See Column 6, lines 11-17. The average fiber diameter ranges disclosed by the reference are sufficiently specific to anticipate the fiber diameter limitation in claims 36-29. See MPEP 2131.03.

Claims 1, 2, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Chvalovsky et al., U.S. Patent 3,854,986.

Chvalovsky et al. discloses a glass fiber having overlapping ranges of components with instant claims 1, 2, and 21. See column 2, line 60 to column 3, line 9. The compositional ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations in claims 1, 2, and 21. See MPEP 2131.03

Claims 1, 2, 8, and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rapp et al., U.S. Patent 5,576,252.

Rapp et al. discloses a glass fiber having overlapping ranges of components with instant claims 1, 2, 8, and 21. See column 1, line 55 to column 2, line 5. The compositional ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations in claims 1, 2, 8, and 21. See MPEP 2131.03.

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Declaration

The Declaration under 37 CFR 1.132 filed on 31 January 2005 is insufficient to overcome the rejection of claims 1, 2, 5, 8, and 21 based upon the 35 U.S.C 102(b) rejections over Fyles et al., Chvalovsky et al., and Rapp et al. as set forth in the last and current Office action because of the following reasons.

A declaration under 37 CFR 1.132 cannot overcome the 102(b) rejections, which are statutory bar rejections.

The declaration refers only to the properties described in the above referenced application and not to the individual claims of the application. Thus, there is no showing of evidence that is commensurate in scope with the claims. In addition to the Applicant's assertion in the declaration that the batch blend can withstand high temperature, the declaration also mentions insulation and acoustical properties, fiberizable properties, and other properties required in aircraft burn-through prevention, which are not limitations of the instantly claimed invention. See MPEP § 716.

The declaration has not provided any experimental data or evidence showing that "the batch blend" would have a higher resistance to high temperatures of the glass fibers of cited prior art. Due to the lack of experimental evidence, applicant's assertions that the unexpected results are mere arguments. See MPEP § 716.01(c).

The declaration has not provided any experimental data or evidence showing that the cited prior art references are inoperable for the purposes of the of high temperature resistance. See MPEP § 716.07.

Response to Arguments

Applicant's arguments filed 31 January 2005 have been fully considered but they are not persuasive.

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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., fibers for fire-blocking blankets, fibers withstanding high temperatures and very low temperatures, acoustical noise dampening, and FAA Directive 14 CFR Parts 25.81) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that "a batch blend to produce a glass composition useful for forming glass fibers of high heat resistance" has the properties and characteristics of a high temperature glass fiber, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's arguments, the recitation "to produce a glass composition useful for forming glass fibers of high heat resistance" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out

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how the language of the claims patentably distinguishes them from the references. See above Examiner's statements in regards to the declaration.

Applicant's arguments that the prior art does not teach a glass fiber having a diameter of 0.5 to 5 micron is not deemed persuasive since the instantly claimed invention is towards a batch blend and not a glass fiber composition.

Applicant argues that the glasses of the cited prior art do not have the capability of withstanding the very high temperatures of the Applicant's batch blend as recited in the instant claims. Additionally, the Applicant asserts that the glasses of the prior art are coarse fibers, which are unable to be fiberized at the diameter, and forming temperatures of the instantly claimed batch blend. Furthermore there is no forming temperature limitation in the instant claims. This is not deemed persuasive since arguments cannot take the place of evidence in the record to overcome a rejection. See MPEP 2145.

Allowable Subject Matter

Claims 18-20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

Claims 3, 4, 6, 7, 9-17, and 22-35 are allowed.

Reason For Allowance

The following is a statement of reasons for the indication of allowable subject matter:

The prior art fails to disclose or suggest a glass according to the limitations of claims 3, 4, 6, 7, 9-17, and 22-35 where the components of a glass fall within the compositional limitations with particular attention to the CaO, SiO₂, Fe₂O₃, and Al₂O₃ content of the glass. The closest prior art is the three references cited in the above rejections. None of the above references alone or in combination disclose or teach the very specific glass compositions as recited in the instant claims indicated allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 571-272-1363. The examiner can normally be reached on 9:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**** Please note that the Examiner Elizabeth A. Bolden will be out of the office for an extended period of time starting on 2 June 2005 and returning approximately 27 June 2005. You can leave me a voicemail message, which I will try to check intermittently and respond back at the earliest time possible. Otherwise, during this period, please contact my supervisor Jerry Lorengo at the above telephone number. Sorry for this inconvenience.****

EAB
11 May 2005


KARL GROUP
PRIMARY EXAMINER
GROUP 1755